REMARKS

Claims 12-20 and 23-38 were presented for examination. Claims 19-20 are withdrawn from consideration pursuant to 37 CFR 1.142(b), leaving Claims 12-18 and 23-38 for consideration upon entry of this amendment.

Claim 35 was objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, i.e., Claim 33. Independent Claim 33 has been amended to cure the improper dependent form of Claim 35.

112, second paragraph rejections

Claims 13 and 31 have been amended to change "expendable"" to "extendable". Claims 33 and 34 have been amended to distinctly claim "forming a deployment region . . . after initiation of the vacuum formation . . . ." Thus, curing the deficiencies noted with respect to Claims 35 and 33, respectively. It is respectfully submitted that these amendments merely make explicit what had been implicit in the claims.

102 rejections

Claims 12, 23-26, 28, and 30 stand rejected as being anticipated by Ang et al. (U.S. Patent 5,792,413). Applicants respectfully traverse.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Ang et al. teach an instrument panel top cover with a seamless breakaway air bag door made as a unitary composite from multiple layers of plastics by extruding a parison with inner and outer layers of different recyclable plastics having different physical characteristics but which are from the same plastics family. The parison is injected and expanded with low pressure gas and forming dies with door scoring tools are closed thereover. The plastics will resultantly conform to the shaping surfaces of the dies to form the composite while the perimeter of the air

bag door is scored. A quantity of the plastic **material interior of the door score lines is removed after the top cover is removed** from the dies so that a seamless or hidden door is provided that can readily break open at the peripheral scores to augment air bag operation when the air bag is triggered. (See Abstract).

More specifically, Ang et al. teach that after the door 44 has been peripherally perforated or scored by the door forming cutters and the hinge forming blades, **the top panel cover is allowed to cool in the mold** and the mold halves are moved to an open position. The cover is then ejected from the mold by ejection pins or other suitable mechanism. Moreover, after ejection, some of the layers of joined composite material M interior of the peripheral score lines 70 of the door is **cut out or otherwise removed by suitable tools** to a depth generally determined by the amount of penetration of the cutters and the hinge forming blades into the plastics material. Col. 4, lines50-61. Thus, Ang et al. teach a two step process to form a weakened tear pattern in the inner surface so that deployment of an air bag causes the deployment region to open along the score lines 70. Furthermore, Ang et al. teaches a step after cooling of the panel cover to remove interior material defined by the score lines after ejection from the mold.

Ang et al. do not teach or suggest forming a deployment region in the inner surface of the instrument panel cover by contacting only the inner surface with at least one scoring device after initiation of the formation of the instrument panel cover creating at least one score therein, **but prior to the cooling thereof**, the at least one score defining the deployment region and **providing a weakened tear pattern in the inner surface so that deployment of an air bag cushion causes the deployment region to open along the at least one score** for deployment of the air bag cushion, as in amended Claim 12. Accordingly, Claim 12, including claims depending therefrom, i.e., Claims 13-32, define over Ang et al.

103 rejections

Claims 12-18, 23-38 stand rejected as being unpatentable over JP 2000159047 in view of JP 2000272459. Applicants respectfully traverse.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Further, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

Neither JP 2000159047 nor JP 2000272459 provides a reason for one of ordinary skill in the art to make the modification necessary to meet claims 12 and 33. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary art reference] could readily be modified to form the [claimed] structure, [t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification") (citation omitted); *In re Stencel*, 828 F.2d 751, 755, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987) (obviousness cannot be established 'by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made'). There is no teaching or suggestions to combine elements of the prior art to produce the present invention. Therefore, claims 12, 33 and 34 are nonobvious in view of the references cited.

Applicants further maintain that the Examiner has used an improper standard in arriving at the rejection of the above claims under section 103, based on improper hind sight which fails to consider the totality of Applicant's invention and to the totality of the cited references. More specifically, the Examiner has used Applicant's disclosure to select portions of the cited references to allegedly arrive at Applicant's invention. In doing so, the Examiner has failed to consider the teachings of the references or Applicant's invention as a whole in

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contravention of section 103, including the disclosures of the references which teach away (See JP 2000159047 teaching formation of the weakened tear pattern on the outer surface as admitted by the Examiner) in contravention of Applicant's invention.

Section 103 sets out the test for obviousness determinations. It states, in pertinent part, that such determinations are to be made by consideration of

> . . . the differences between subject matter sought to be patented and the prior art such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the [pertinent] art.

In making a Section 103 rejection, the Examiner bears the burden of establishing a prima facie case of obviousness. In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1998). The Examiner ". . . can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references". Id.

In applying Section 103, the U.S. Court of Appeals for the Federal Circuit has consistently held that one must consider both the invention and the prior art 'as a whole', not from improper hindsight gained from consideration of the claimed invention. See, *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and cases cited therein. According to the *Interconnect* court:

> [n]ot only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time - a technician without our knowledge of the solution.

Id. Also critical to this Section 103 analysis is that understanding of "particular results" achieved by the invention. *Id.*

"[T]here must be some reason for the combination other than the hindsight gleaned from the invention itself." *Id.* Stated in another way, "[i]t is impermissible to use the

claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch* 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

A finding of "obvious to try" does not provide the proper showing for an obviousness determination. The requirement for a determination of obviousness is that "both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure" (emphasis added). *In re Dow Chem.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). An Examiner, then, cannot base a determination of obviousness on what the skilled person in the art might try or find obvious to try. Rather, the proper test requires determining what the prior art would have led the skilled person to do.

Accordingly, it respectfully submitted that claims 12, 33 and 34 are allowable over the references cited.

Furthermore, turning now to Claims 12, 33 and 34, the same have been amended to require, among other elements, forming a deployment region in the inner surface of the instrument panel cover by **contacting *only* the inner surface** with at least one scoring device after initiation of the formation of the instrument panel cover creating at least one score therein. JP 2000272459 merely teaches a drill 9a that penetrates the outer skin layer 3 from the inner surface of a molded multiplayer object 1B in order to form a hole therethrough. The opening of the hole on the outer skin layer is then closed by thermofusion of the surface of the outer skin layer that touches the surface of a section 7 of a vacuum forming mold. See Abstract and Figures 1-6. Thus, JP 2000272459 teaches contacting the inner surface and outer surface of the instrument panel cover with drill 9a to form the hole therethrough with specific reference to the four figures of Figure 6 depicting the drilling and later thermofusion process. Thus, JP2000272459 teaches away from contacting only the inner surface with at least one scoring device, as in Claim 12 and similarly claimed in Claims 33 and 34.

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Accordingly, it respectfully submitted that claims 12, 33 and 34, including claims depending therefrom, i.e., 13-18, 21-32, and 35-38 are allowable over the references cited.

Summary

Attached hereto is a marked-up version of the claims proposed by the current amendment. The attached page is captioned "Marked Up Version of the Prior Pending Claims".

In view of the above, it is respectfully submitted that the instant application is in a condition for allowance. Such action is most earnestly solicited. If for any reason the Examiner feels that consultation with Applicant's attorney would be helpful in the advancement of the prosecution, he is invited to call the telephone number below for an interview.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

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MARKED UP VERSION OF THE PRIOR PENDING CLAIMS

IN THE CLAIMS:

Please amend the Claims shown in marked up format as follows:

Claim 12. (Amended) A method of forming a hidden, integral passenger air bag door in an instrument panel cover, the method comprising:

forming the instrument panel cover having an inner surface and an opposing outer surface, and

forming a deployment region in the inner surface of the instrument panel cover by contacting only the inner surface with at least one scoring device after initiation of ~~during~~ the formation of the instrument panel cover creating at least one score therein, but prior to the cooling thereof, the at least one score defining the deployment region and providing a weakened tear pattern in the inner surface so that deployment of an air bag cushion causes the deployment region to open along the at least one score for deployment of the air bag cushion.

Claim 13. (Amended) The method as set forth in claim 12, wherein forming the deployment region comprises:

providing at least one scoring member which is ex~~p~~tendable and retractable upon actuation of the device;

contacting the at least one scoring member with the instrument panel cover at only the inner surface thereof during the formation of the instrument panel cover; and

forming the at least one score by advancing the at least one scoring member into the instrument panel cover from the inner surface thereof, the advancement of the at least one scoring member causing the instrument panel cover to thin out in predetermined locations which define the at least one score.

Claim 31. (Amended~~new~~) The method as in claim 28, wherein the at least one scoring device comprises a scoring blade which forms apart of a moveable cylinder, the at least one scoring blade being exptendable and retractable relative to the cylinder, the cylinder and at least one scoring blade being orientated above the body so that upon actuation thereof, the cylinder and at least one scoring blade are lowered to contact the body and form the at least one score.

Claim 33. (Amended~~new~~) A method for forming a hidden, integral passenger air bag door in a portion of an instrument panel cover, comprising:

vacuum forming the instrument panel cover having an inner surface and an opposing outer surface; and

forming a deployment region in the inner surface of the instrument panel cover by contacting only the inner surface with at least one scoring device after initiation of ~~during~~ the vacuum formation of the instrument panel cover creating at least one score therein, but prior to the cooling thereof, the at least one score defining the deployment region and providing a weakened tear pattern in the inner surface wherein the deployment of an air bag cushion causes the deployment region of the instrument panel cover to tear open along at the at least one score for deployment of the air bag cushion.

Claim 34. (Amended~~new~~) A method for forming a hidden, integral passenger air bag door in a portion of an instrument panel cover, comprising:

applying a quantity of thermoplastic material to a vacuum forming tool;

vacuum forming the instrument panel cover having an inner surface and an opposing exterior surface; and

forming a deployment region in the inner surface of the instrument panel cover by contacting only the inner surface with at least one scoring device after initiation of~~during~~ the vacuum formation of the instrument panel cover creating at least one score therein, the at least one score defining the deployment region and providing a weakened tear pattern in the inner surface wherein the deployment of an air bag cushion causes the deployment region of the instrument panel cover to tear open along at the at least one score for deployment of the air bag

cushion, the deployment region being formed aftersimultaneously or during the vacuum forming of the instrument panel, but prior to the cooling thereof.